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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,935	11/30/2001	Zhiming Zhou	56196US011	5911

32692 7590 09/24/2003

3M INNOVATIVE PROPERTIES COMPANY  
PO BOX 33427  
ST. PAUL, MN 55133-3427

EXAMINER

BISSETT, MELANIE D

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/998,935

Applicant(s)

ZHOU ET AL.

Examiner

Melanie D. Bissett

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1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-35 is/are pending in the application.
- 4a) Of the above claim(s) 16-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-15,34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. The rejections based on 35 USC 103 and claim objections have been withdrawn based on the applicant's arguments. However, new rejections based on 35 USC 103 have been provided.

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 5-15, and 34-35 are rejected under 35 U.S.C. 103(a) as being obvious over Gieselman.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the

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reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

4. Gieselman teaches wet-skin adhesives including a special pressure-sensitive adhesive component having an acrylic copolymer comprising an acrylate ester monomer and an acidic monomer (abstract). Preferably, the acrylate ester monomer is chosen from n-butyl acrylate, 2-ethylhexyl acrylate, isooctyl acrylate, and lauryl acrylate (col. 2 lines 54-61). The applicant lists the first three preferred monomers as acrylate esters of non-tertiary alcohols whose homopolymer has a  $t_g$  no greater than 0 °C. Gieselman prefers the acidic monomer to be an unsaturated carboxylic acid monomer present in an amount of about 1-about 50% by weight based on the total weight of copolymerizable monomers (col. 2 line 62-col. 3 line 4). Tackifiers and plasticizers are optional additives (col. 3 lines 5-12), teaching the use of amounts less than those claimed by the applicant. At least example 12 indicates a PSA composition having small amounts of carboxylic acid equivalents and having no added plasticizers or tackifiers, where the composition is applied to a backing.

5. However, the reference does not indicate the applicant's claimed combination of materials with a specific amount of bis-amide crosslinker. Gieselman does suggest the use of bisamide crosslinkers, including a specific bisamide fitting the applicant's claim 10 (col. 8 lines 22-28). The crosslinkers are used in amounts of 0.1-10 parts per 100 parts of monomer (col. 9 lines 4-6), and the bisamide crosslinkers are used to impart heat-activated crosslinking with the acid functional groups. Thus, it is the examiner's

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position that it would have been prima facie obvious to use the noted bisamide crosslinking agent in any amount necessary to effectively cross-link the adhesives using heat. Note that the reference suggests as little as 1% acid monomer and as much as ~10% crosslinking agent. One of ordinary skill in the art would recognize that due experimentation of material amounts would lead to the applicant's claimed ratio of equivalents, based on the teachings of the reference.

6. Regarding claims 34-35, it is noted that the reference teaches the use of the same materials employed by the applicant. Thus, it is the examiner's position that the material of the reference would inherently have the same removability properties as those claimed by the applicant.

7. Claims 1, 5-15, and 34-35 are rejected under 35 U.S.C. 103(a) as being obvious over Peloquin et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and

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reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

8. Peloquin discloses adhesives useful for tapes, labels, decals, car moldings, etc., comprising a copolymer of alkyl acrylate monomer and an optional acidic monomer (abstract). Pressure-sensitive adhesives are applied to a backing (col. 11 lines 42-62). Preferred acrylate monomers include isooctyl acrylate, 2-ethylhexyl acrylate, 2-methylbutyl acrylate, and n-butyl acrylate (col. 8 lines 20-22). The applicant lists the preferred monomers as acrylate esters of non-tertiary alcohols whose homopolymer has a  $t_g$  no greater than 0 °C. Peloquin prefers unsaturated carboxylic acid monomer which are present in an amount of about 2-about 10% by weight based on the total weight of copolymerizable monomers (col. 9 lines 10-22; lines 57-63). Tackifiers and plasticizers are optional additives (col. 11 lines 37-39), teaching the use of amounts less than those claimed by the applicant. The examples indicate a PSA composition having small amounts of carboxylic acid equivalents and having no added plasticizers or tackifiers, where the composition is applied to a backing.

9. However, the reference does not indicate the applicant's claimed combination of materials with a specific amount of bis-amide crosslinker. Peloquin does suggest the

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use of bisamide crosslinkers, including a specific bisamide fitting the applicant's claim 10 (col. 10 lines 42-49). The crosslinkers are used in amounts of 0.1-10 parts per 100 parts of monomer (col. 11 lines 28-35), and the bisamide crosslinkers are used to impart heat-activated crosslinking with the acid functional groups. Thus, it is the examiner's position that it would have been prima facie obvious to use the noted bisamide crosslinking agent in any amount necessary to effectively cross-link the adhesives using heat. Note that the reference suggests as little as 2% acid monomer and as much as ~10% crosslinking agent. One of ordinary skill in the art would recognize that due experimentation of material amounts would lead to the applicant's claimed ratio of equivalents, based on the teachings of the reference.

10. Regarding claims 34-35, it is noted that the reference teaches the use of the same materials employed by the applicant. Thus, it is the examiner's position that the material of the reference would inherently have the same removability properties as those claimed by the applicant.

### ***Response to Arguments***

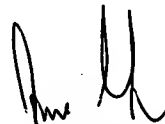
11. Applicant's arguments with respect to claims 1 and 5-15 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (703) 308-6539. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

mdb



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700